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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/865,859      | 05/25/2001  | Mary E. Gerritsen    | 10466/32            | 9530             |

28442 7590 11/23/2001

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EXAMINER

DESAI, RITA J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1625

DATE MAILED: 11/23/2001

3

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/865,859

Applicant(s)

GERRITSEN ET AL.

Examiner

RITA J. DESAI

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6 , 9 ,10 , 12-16 in part , drawn to a method of using these compounds , wherein the compounds have the formula I , classified in class 548, 549 , 514 , subclass , 122, 30, 336. A further restriction of a single disclosed species is required.
- II. Claims 1-6 , 9 , 10, 12- 16 in part, drawn to method of using these wherein the compounds have the formula II, classified in class 548, 514 subclass 120 , 336. A further election of a single disclosed species is required.
- III. Claims 1-6, 9 ,10 , 12-16 ,in part , drawn to a method of using these compounds having a formula III , classified in class 548, 514 , subclass 125, 360, 361. A further election of a single disclosed species is required.
- IV. Claims 1-6 , 9,10 , 12-16 in part, drawn to method of using these compounds of formula IV, wherein v and x are both Nitrogen containing groups , classified in class 546, 514, subclass 268.1, 222.2, 228.2. A further election of a single disclosed species is required.
- V. Claims 1-6 ,9 ,10, 12-16 in part , drawn a method of treating using compounds of formula IV, wherein v and x are different than in group IV. *This group is subject to further restriction*, classified in various classes and subclasses. A further election of a single disclosed species is required.

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- VI. Claims 1-6 ,9 ,10 , 12-16 in part , drawn to a method of using these compounds of formula V, classified in class 544, 546 , 514 subclass various. A further election of a single disclosed species is required.
- VII. Claims 1-6 , 9, 10, 12-16 in part drawn to a method of using compounds of formula VI, classified in class 548, 514 , subclass various. A further election of a single disclosed species is required.
- VIII. Claims 1, 7, 12, 17 in part , drawn to a method wherein the PPAR gamma ligand is a PGA1 , classified in different classes and , subclasses. A further election of a single disclosed species is required.
- IX. Claim 1, 7 , 12, 17 in part , drawn to a method wherein PPAR gamma ligand is different . *Subject to further restriction* , classified in various classes and subclasses. A further election of a single disclosed species is required.
- X. Claims 1, 12, 12, 17 drawn to a method to a method wherein the PPAR ligand is a fatty acid , classified in various classes and subclasses. A further election of a single disclosed species is required.
- XI. Claims 19-29 in part , drawn to a method of providing an article of manufacture, classified in class 424, 514 and in various subclasses. This group is subject to further restriction. A further election of a single disclosed species is required.
- XII. Claim 11 , drawn to a method of treating tumors , classified in class 514, subclass various. A further election of a single disclosed species of compound/ligand/ fatty acid is required.

The inventions are distinct, each from the other because of the following reasons:

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Inventions I to XII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to ligands of a different chemical formulas to treat different diseases. Also claims 19-29 are drawn towards an article of manufacture.

The different ligands have a different core structure and hence have different properties and geometry and bonding. Can all compounds which are analgesic, but have different chemical compounds be one invention? Applicants compounds have numerous cores and hence these are different inventions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II- XII, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Paul Rauch on 11/19/2001 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RITA J. DESAI whose telephone number is 703-305-1868. The examiner can normally be reached on Monday - Friday, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

R.D.  
November 19, 2001

*Alan L Rotman*  
**ALAN L. ROTMAN**  
**PRIMARY EXAMINER**